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EXAMINER	
CHAMPAGNE, DONALD	

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UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte DIRK M. BEYER,
CIPRIANO A. SANTOS, and
BILAL IQBAL

Appeal 2009-014781
Application 09/853,961
Technology Center 3600

Before HUBERT C. LORIN, ANTON W. FETTING, and
BIBHU R. MOHANTY, *Administrative Patent Judges*.

LORIN, *Administrative Patent Judge*.

DECISION ON APPEAL[1]

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, or for filing a request for rehearing, as recited in 37 C.F.R. § 41.52, begins to run from the "MAIL DATE" (paper delivery mode) or the "NOTIFICATION DATE" (electronic delivery mode) shown on the PTOL-90A cover letter attached to this decision.

STATEMENT OF THE CASE

Dirk M. Beyer et al. (Appellants) seek our review under 35 U.S.C. § 134 (2010) of the final rejection of claims 1-10 and 20-30. We have jurisdiction under 35 U.S.C. § 6(b) (2010).

SUMMARY OF DECISION

We AFFIRM. [2]

THE INVENTION

This invention is a method and apparatus for "on-line selection of tasks such that a desired distribution of these tasks is followed." Specification 1:6-8.

Claim 1, reproduced below, is illustrative of the subject matter on appeal.

> 1. A method of task selection comprising the steps of:
>
> [A] determining a specified distribution of a plurality of tasks;
>
> [B] assuming a first event in a sequence of events occurs, each event in said sequence of events triggering execution of one of said plurality of tasks;
>
> [C] determining a plurality of hypothetical distributions of said plurality of tasks for each task hypothetically selected for execution from said

[2] Our decision will make reference to the Appellants' Appeal Brief ("Br.," filed Jun. 8, 2007) and to the Examiner's Answer ("Answer," mailed Sep. 20, 2007).

plurality of tasks; and

> [D] selecting a first task for execution from said plurality of tasks, which when selected provides a corresponding hypothetical distribution of said plurality of tasks that is closest to said specified distribution of said plurality of tasks for implementation of said specified distribution.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Cannon	US 6,286,005 B1	Sep. 4, 2001

The following rejection is before us for review:

1. Claims 1-10 and 20-30 are rejected under 35 U.S.C. § 102(e) as being anticipated by Cannon.

ISSUE

The issue is whether claims 1-10 and 20-30 are anticipated under 35 U.S.C. § 102(e) by Cannon. Specifically, the issue is whether the Appellants have shown that the Examiner erred in finding that claims 1 and 20 read on Cannon.

FINDINGS OF FACT

We find that the following finding of fact (FF) is supported by at least a preponderance of the evidence. *Ethicon, Inc. v. Quigg*, 849 F.2d 1422, 1427 (Fed. Cir. 1988) (explaining the general evidentiary standard for proceedings before the Office).

We adopt the Examiner's findings of facts as related to the rejection of claims 1 and 20 under 35 U.S.C. § 102 (e) as being anticipated by Cannon. Answer 3-4.

ANALYSIS

The rejection of claims 1-10 and 20-30 under §102(e) as being anticipated by Cannon

The Appellants argue claims 1-10 and 20-30 as a group. Br. 16-17. We select claim 1 as the representative claim for this group, and the remaining claims 2-10 and 20-30 stand or fall with claim 1. 37 C.F.R. § 41.37(c)(1)(vii) (2010).

The Appellants argue that each of the recited steps, labeled A-D above, is not anticipated by Cannon. Br. 11-17.

As to step A, the Appellants argue that Cannon does not describe this step. Br. 12-13. The Appellants argue:

> For example, if the plurality of tasks is advertisement, the specified distribution describes the overall presentation of the advertisements to a specific group of customers. . . .
>
> Instead, the Cannon reference teaches a method for selecting an additional spot for inclusion within an advertising schedule. Specifically, the Cannon reference teaches the selection of one of a plurality of possible advertising time spots.

Br. 12.

The Examiner agrees with the Appellants' description of the Cannon reference but argues that when given the broadest reasonable interpretation, step A reads on Cannon. Answer 5-6. To support their argument, the

Examiner notes that the Specification contains no express definition for any of the claimed terms and argues that the Appellants are reading limitations from the Specification into the claims. Answer 5.

We agree with the Examiner. The Appellants argument compares an example from the Specification to the Cannon reference in order to conclude that Cannon does not anticipate step A. *See* Br. 12-13. However, the issue is not whether Cannon anticipates an embodiment disclosed in the Specification, but whether Cannon expressly or inherently describes step A. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." *Verdegaal Bros., Inc. v. Union Oil Co. of Cal.*, 814 F.2d 628, 631 (Fed. Cir. 1987). The Appellants do not challenge whether Cannon expressly or inherently describes step A *as set forth in the claim.*

Further, we note that the Appellants do not challenge whether the Examiner's construction of step A as broadly encompassing Cannon's description is reasonable. During examination of a patent application, a pending claim is given the broadest reasonable construction consistent with the specification and should be read in light of the specification as it would be interpreted by one of ordinary skill in the art. *In re Am. Acad. of Sci. Tech Ctr.*, 367 F.3d 1359, 1364 (Fed. Cir. 2004).

> [W]e look to the specification to see if it provides a definition for claim terms, but otherwise apply a broad interpretation. As this court has discussed, this methodology produces claims with only justifiable breadth. *In re Yamamoto*, 740 F.2d 1569, 1571 (Fed. Cir. 1984). Further, as applicants may amend claims to narrow their scope, a broad construction during prosecution creates no

> unfairness to the applicant or patentee. *Am. Acad.*, 367 F.3d at 1364.

In re ICON Health and Fitness, Inc., 496 F.3d 1374, 1379 (Fed. Cir. 2007). Limitations appearing in the specification but not recited in the claim are not read into the claim. *E-Pass Techs., Inc. v. 3Com Corp.*, 343 F.3d 1364, 1369 (Fed. Cir. 2003). We note that the Appellants did not file a reply brief.

The Examiner has established a prima facie showing that step A is anticipated by Cannon (*see* Answer 3 and 5), and we find the Appellants' argument unpersuasive as to error in the Examiner's showing.

As to step B, similar to their argument to traverse step A above, the Appellants argue that Cannon does not describe step B by providing an example from the Specification and comparing the example to Cannon. Br 13-14. The Examiner again responds that the Appellants are reading limitations from the Specification into the claims and that given the broadest reasonable construction, step B read on Cannon. Answer 6-7. For the same reasons as discussed above with regards to step A, we agree with the Examiner. The Examiner has established a prima facie showing that step B is anticipated by Cannon (*see* Answer 3 and 6), and we find the Appellants' argument unpersuasive as to error in the Examiner's showing.

As to steps C and D, the Appellants again argue that Cannon does not describe steps C and D by providing an examples from the Specification and comparing the examples to Cannon. Br. 14-15. For example, the Appellants argue that "embodiments of the present invention are distinguishable from the Cannon reference in that scoring is determined from a singular plurality of tasks, and not from a multiple plurality of possible tasks" (Br. 14) and "the Cannon reference does not disclose the selection of a task from a singular and unvarying plurality of tasks used to determine a specified

distribution" (Br. 15). The Examiner again responds that the Appellants are reading limitations from the Specification into the claims and that given the broadest reasonable construction, step B read on Cannon. Answer 8-10. Further, the Examiner point out that claim 1 does not recite *calculating* a hypothetical distribution (Br. 8) or a *singular and unvarying* plurality of tasks (Br. 10).

Again, we agree with the Examiner for the reasons discussed above with regards to step A. The Examiner has established a prima facie showing that steps C and D are anticipated by Cannon (*see* Answer 4 and 8-10), and we find the Appellants' argument unpersuasive as to error in the Examiner's showing.

Finally, we note that claims 20-30 recite an apparatus, unlike claim 1, which is directed to a method. "[A]pparatus claims cover what a device is, not what a device does." *Hewlett-Packard Co. v. Bausch & Lomb Inc*., 909 F.2d 1464, 1468 (Fed. Cir. 1990). However, the Appellants' rely upon their same arguments to traverse the rejection of claim 20 made to traverse the rejection of claim 10. *For example, see* Br. 12 ("claims 1 and 20 set forth a method"). For the reasons discussed, above we find that the Examiner has established a prima facie showing in rejecting claims 20-30 as being anticipated by Cannon and find that the Appellants' argument unpersuasive as to error in the Examiner's showing. Further, we note that the Appellants' argument does not challenge whether the *structure* required by claim 20 is anticipated by Cannon.

> Filing a Board appeal does not, unto itself, entitle an appellant to *de novo* review of all aspects of a rejection. If an appellant fails to present arguments on a particular issue – or, more broadly,

> on a particular rejection – the Board will not, as a general matter, unilaterally review those uncontested aspects of the rejection. . . Thus, the Board will generally not reach the merits of any issues not contested by an appellant.

In re Frye, 94 USPQ2d 1072, 1075 2009-006013 (BPAI 2010)(precedential).

Accordingly, we find that the Appellants have not overcome the rejection of claims 1-10 and 20-30 under 35 U.S.C. § 102(e) as being anticipated by Cannon.

DECISION

The decision of the Examiner to reject claims 1-10 and 20-30 is affirmed.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2010).

AFFIRMED

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